

**REMARKS**

After entering the above amendments, claims 78-80, 83-85, and 87-142 will be pending. Reconsideration and allowance of the above-referenced application are respectfully requested in light of the above-marked amendments and the foregoing remarks.

**Summary of Rejections.** The Office has rejected claim 105 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; claims 78-80, 83-85, and 87-107, 110-112, and 114-132 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; claims 90 and 117 under 35 U.S.C. § 112, second paragraph, as being vague and indefinite; claims<sup>1/</sup> 78-80, 83-85, 87-97, 99-107, 110-112, 114-124 and 126-132 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2003/0069869 to Gronau et al. (hereinafter "Gronau"); and claims 98 and 125 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gronau in view of U.S. Patent Application Publication No. 2002/0147626 to Zagotta et al. (hereinafter "Zagotta").

**Summary of Amendments.** Claims 1, 105 and 132 have been amended. Claims 81, 82, 86, 108, 109 and 113 have been canceled without prejudice or disclaimer. New claims 133-142 have been added. The amendments and the new claims are fully supported by the original specification, at least as follows: The amendments to claims 1, 105 and 132 find support, inter alia, in: paragraphs 82, 96, 327-334, 368, 432, and 567; and Table A – see "strategy", "framing", "strategy modeling", and "decision model." The new claims 133-142 find support, inter alia, in Table C and paragraph 60 of the published specification. No new matter has been added.

**Rejections under 35 USC §112, First Paragraph**

Claims 105 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

Claim 105 has been amended to recite “one or more computing systems” as opposed to “means” to overcome the issue relating to a single means claim.

For at least these reasons, withdrawal of the pending rejection under 35 U.S.C. §101 is respectfully requested.

**Rejections under 35 USC §112, Second Paragraph**

Claims 78-80, 83-85, and 87-107, 110-112, and 114-132 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 90 and 117 are rejected as being vague and indefinite for use of the phrase “modeled crudely.” These rejections are respectfully traversed.

Claims 78 and 105 have been amended to replace “capability to interact” with “interacts”. The term “crudely” has been deleted from claims 90 and 117.

For at least these reasons, withdrawal of the pending rejection under 35 U.S.C. §101 is respectfully requested.

**Rejections under 35 USC §102**

Claims 78-80, 83-85, 87-97, 99-107, 110-112, 114-124 and 126-132 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Gronau. This rejection is respectfully traversed.

To present a valid anticipation rejection under 35 U.S.C. §102, the Office must identify a single prior art reference in which “each and every element as set forth in the claim is found,

either expressly or inherently described.” MPEP §2131 quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The rejection over Gronau fails to satisfy this burden with regards to the currently pending claims.

Claim 78 recites the following features:

An iterative computer-implemented method for creating and evaluating strategies, comprising:

providing a plurality of modules for the creation and evaluation of strategies, each strategy representing a set of rules specifying a course of action to take for a decision out of one or more decisions, the modules comprising:

a team development module for developing a list comprising components of a strategy modeling team;

a strategy situation analysis module for framing a decision situation, the framing comprising identifying parameters of the decision;

a data request and reception module for designing and executing logistics of specifying, acquiring, and loading data required for the decision and modeling of the strategy, the data request and reception module further constructing a data dictionary;

a data transformation and cleansing module for verifying the data, and transforming the data into a form that is used to build quantitative models used to develop the strategies;

a decision key and intermediate variable creation module for computing intermediate variables from the data, each intermediate variable of the intermediate variables encapsulating dependent variables, independent variables and decision keys;

a data exploration module for determining the effectiveness of each intermediate variable of the intermediate variables and each decision key of the decision keys;

a decision model structuring module for formalizing relationships between the one or more decisions, the decision keys, the intermediate variables, value variables representing a function to be maximized, and constraint variables representing limits on the strategies, to obtain a decision model with a specific structure;

a decision model quantification module for encoding information into a decision model;

a strategy creation module for determining the strategies that a client can test; and

a strategy testing module for testing the strategies to guide refinement of strategies and refinement of a decision model and to select a best strategy for deployment;

wherein each of said modules has capability to interact with an expert task manager, wherein said expert task manager provides expert knowledge about strategy modeling processes to the modules; and

executing the modules using at least one data processor forming part of a computer system.

In contrast to claim 78, Gronau describes an enterprise performing a series of steps on an application to perform strategic planning. The strategy plan constitutes optimum allocation of resources available in a resource database. To performing strategic planning, the enterprise uses a profile builder to create its profile on the application. The profile consists of current financial information of the enterprise. Then, the enterprise defines rules (including policies, axioms, values and priorities) that need to be used to achieve the objectives. The defining of the rules constitutes selecting the rules out of a predefined rules database or creating the rules and then adding the rules to the rules database. Then the enterprise defines, using the defined rules, objectives that need to be achieved. Based on the objectives, the available resources are assessed and allocated according to each objective. A measurement and assessment function keeps a track of status of activities and achievement of the objectives in the strategy planning process.

The Examiner alleges on page 5 of the Office Action that Gronau's resources constitute the following feature of claim 78: "a team development module for developing a list comprising components of a strategy modeling team." Applicants respectfully disagree for at least the reason that follows.

While Gronau's resources are allocated according to Gronau's rules, Gronau's resources do not develop a list comprising components of a strategy modeling team, as recited in claim 78.

Therefore, Gronau fails to disclose the aforementioned feature of claim 78.

Further, the Examiner alleges on page 5 of the Office Action that Gronau's defining of the objectives constitutes the framing a decision situation, as recited in claim 78. Applicants respectfully disagree for at least the reason that Gronau is completely silent about the defining

(of objectives) comprising identifying parameters of the decision, much less the following feature of claim 78: "a strategy situation analysis module for framing a decision situation, the framing comprising identifying parameters of the decision."

Therefore, Gronau fails to disclose the aforementioned feature of claim 78.

Furthermore, the Examiner alleges on page 5 of the Office Action that Gronau's profile builder constitutes the data request and reception module, as recited in claim 78. Applicants respectfully disagree for at least the reason that the profile builder does not construct a data dictionary, as recited in claim 78. Rather Gronau's profile builder merely builds a profile of the enterprise constituting current financial information of the enterprise.

Therefore, Gronau fails to disclose the following feature of claim 78: "a data request and reception module for designing and executing logistics of specifying, acquiring, and loading data required for the decision and modeling of the strategy, the data request and reception module further constructing a data dictionary."

Even further, the Examiner alleges on page 5 of the Office Action that Gronau's rules database constitutes the data transformation and cleansing module recited in claim 78. Applicants disagree for at least the reason that follows.

While Gronau discloses rules being followed to create strategic plans, Gronau's rules database does not transform data into a form that is used to build quantitative models used to develop strategies, as recited in claim 78.

Therefore, Gronau fails to disclose the following feature of claim 78: "a data transformation and cleansing module for verifying the data, and transforming the data into a form that is used to build quantitative models used to develop the strategies."

Further, the Examiner alleges on page 5 of the Office Action that Gronau's rules database constitutes the decision key and intermediate variable creation module recited in claim 78.

Applicants disagree for at least the reasons that follow.

While Gronau's rules database provides rules to create strategic plans, Gronau is completely silent about the rules database "computing intermediate variables from the data, each intermediate variable of the intermediate variables encapsulating dependent variables, independent variables and decision keys."

Therefore, Gronau fails to disclose the following feature of claim 78: "a decision key and intermediate variable creation module for computing intermediate variables from the data, each intermediate variable of the intermediate variables encapsulating dependent variables, independent variables and decision keys."

It is submitted that since Gronau does not disclose the intermediate variables, as noted above, Gronau further fails to disclose the following feature of claim 1: "a data exploration module for determining the effectiveness of each intermediate variable of the intermediate variables and each decision key of the decision keys."

Further, the Examiner alleges on page 5 of the Office Action that Gronau's rules database constitutes the decision model structuring recited in claim 78. Applicants disagree for at least the reasons that follow.

While Gronau's rules database provides rules to create strategic plans, Gronau is completely silent about the following feature of claim 1: "a decision model structuring module for formalizing relationships between the one or more decisions, the decision keys, the intermediate variables, value variables representing a function to be maximized, and constraint

variables representing limits on the strategies, to obtain a decision model with a specific structure.”

Therefore, Gronau fails to disclose the aforementioned feature of claim 78.

Further, the Examiner alleges on page 6 of the Office Action that Gronau's measurement and assessment function constitutes the strategy testing module recited in claim 78. Applicants disagree for at least the reason that follows.

Gronau's measurement and assessment function keeps a track of status of activities and achievement of the objectives in Gronau's strategy planning process. Gronau merely discloses updating, when rules change, resources for consideration in future plans instead of refining the plans. Therefore, the measurement and assessment function does not test the strategies to guide refinement of strategies. Furthermore, the measurement and assessment function does not test the strategies to guide refinement of decision model. Furthermore, Gronau is silent about the selection of a best strategy.

Therefore, Gronau fails to disclose the following feature of claim 1: “a strategy testing module for testing the strategies to guide refinement of strategies and refinement of a decision model and to select a best strategy for deployment.”

In view of the above-noted points, claim 78 is allowable over Gronau, and the rejection under 35 U.S.C. §102(e) of claim 78, as well as claims 79-80, 83-85, 87-104, at least by reason of their dependency, should be withdrawn.

Independent claims 105 and 132, although of different scope, include features similar to those noted above with respect to claim 78. Therefore, claims 105 and 132, as well as claims 106, 107, 110-112, and 114-131, at least by reason of their dependency, are allowable over

Gronau, and the rejection under 35 U.S.C. §102(e) of those claims should be withdrawn, for at least this reason.

**Rejections under 35 USC §103**

Claims 98 and 125 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gronau in view of Zagotta. This rejection is respectfully traversed.

For a proper rejection under 35 U.S.C. §103(a), the Office “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness” and must therefore present “a clear articulation of the reason(s) why the claimed invention would have been obvious.” MPEP §2142. An obviousness rejection “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” MPEP §2141 quoting *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1386, 1385 (2007). This rationale must include a showing that all of the claimed elements were known in the prior art and that one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, to produce a combination yielding nothing more than predictable results to one of ordinary skill in the art. *KSR*, 82 USPQ2d at 1395. MPEP §2141.02 further notes that “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The rejections over the cited references fail to satisfy this burden with regards to the currently pending claims.

Claim 98 depends from claim 78, and includes all the features recited therein. Although Zagotta describes implementing a shared strategic plan, Zagotta fails to cure the noted deficiencies of Gronau. Therefore, claim 98 is allowable over Gronau and Zagotta, whether



taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 98 should be withdrawn.

Claim 125, although of different scope, includes features similar to those noted above with respect to claim 98. Therefore, claim 125 is allowable over Gronau and Zagotta, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 125 should be withdrawn.

### **CONCLUSION**

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Applicant asks that all claims be allowed.

If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below. The Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 35006-556F01US.

Respectfully submitted,

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